UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,088	11/23/1999	EDWARD A. RICHLEY	D/98588	4649

25453 7590 05/09/2003

PATENT DOCUMENTATION CENTER
XEROX CORPORATION
100 CLINTON AVE., SOUTH, XEROX SQUARE, 20TH FLOOR
ROCHESTER, NY 14644

EXAMINER
LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/448,088	RICHLEY ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Requesting Continued Examination (RCE)

1. Receipt is acknowledged of the Requesting Continued Examination (RCE) and Amendment field 09 April 2003.

Obviousness-Type Double Patenting

2. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,542,083 B1 (hereinafter '083).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1 and 3 of the instant application, Applicants claim a system for **identification and tracking of tags distribute in a room**, the system comprising "a **laser base station** for scanning **laser beams**"/ "at least **two laser base stations**", "a **tag reactive to incident laser beams** to provide **a data signal**", "a **tag tracking system** receiving input from the laser base station**, the tracking system storing state records of position and informational content of the tag**", ... and "the tag tracking system determines **angular position** of the tag with respect to the laser base station"/"the tag tracking system determines **an absolute position** of the tag in the room based on the input from the at least two laser base stations". The '083 patent discloses a system for **identification and tracking of tags distribute in a room**, the system comprising "a **laser base station** for scanning **laser beams**"/ "at least **two laser base stations**", "a **tag reactive to incident laser beams** to provide **a radio data signal**", ... "a **tag tracking system** receiving input from the laser base station ...**, the tracking system storing state records of position and informational content of the tag**", ... and "the tag tracking system determines **angular position** of the tag with

respect to the laser base station"/"the tag tracking system determines **an absolute position** of the tag in the room based on the input from the at least two laser base stations". Although the scope of claims 1 and 3 of the present application and claims 1-3 of '083 patent are almost identical, the difference between the present claimed invention and the '083 patent is that the present claimed invention is a broader recitation of the '083 patent (e.g., the present claimed invention recites "a **tag reactive to incident laser beams** to provide **a data signal**", etc." whereby the '083 patent recites "a **tag reactive to incident laser beams** to provide **a radio data signal**", etc."). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-3 of '083 patent as a general teaching for having a system for **identification and tracking of tags distribute in a room** with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3, 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et al (US 5,963,134) in view of Schleipen (US 6,278,538).

Re claims 1, 3, 4 and 9, Bowers et al discloses a system 10 for identification and tracking of tags 54 distributed in a room. The system comprising a base station 42 for scanning beam; a tag 54 reactive to incident beams; and a tag tracking system 52 receiving input from the base station 42; the tag tracking system 52 storing state records of position and information content of the tag 54; wherein the tag 54 is passive (figs. 1-4; col. 7, line 8 through col. 10, line 64).

Bowers et al fails to teach or fairly suggest that the base station is a laser base station and that the tag tracking system determines angular position of the tag with respect to the laser base

station and comprising at least two laser base stations wherein the tag tracking system determines absolute position of the tag.

Schleipen teaches an angular position Po (θ_{PO} , ϕ_{PO}) is determined by a laser base station [46, 48] and a detector 49 (figs. 4A-B; col. 4, line 52 through col. 5, line 31).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schleipen into the teachings of Bowers et al in order to provide Bowers et al with a more accurate system, wherein the laser beam would provide the system with a more accurate result and the exact location/position of an object can be established by determining its angular position. Furthermore, such modification would have Bowers et al with a more user-friendly system, in which it would provide the user an organized inventory storage record and would save a lot of time for the user in finding an object. Accordingly, such modification would have been a mere duplication of elements (i.e., two laser base stations) as taught by Bowers et al, and therefore an obvious expedient.

6. Claims 5-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et al as modified by Schleipen as applied to claim 1 above, and further in view of Moran et al (US 6,005,482). The teachings of Bowers et al as modified by Schleipen have been discussed above.

Re claims 5-8 and 10-13, Bowers et al/Schleipen have been discussed above but fails to expressly disclose or fairly suggest that the tag is active, having an internal power supply to power a data broadcast element; an optical data output element; a radio data output element; an acoustic data output element.

Moran et al teaches the above limitation radio tags 110, infrared tags 116, acoustic tags 122 (figs. 2 & 3; col. 8, line 16 through col. 9, line 9).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Moran et al into the teachings of Bowers et al/Schleipen in order to provide the user with the flexibility to retrieve the output data in various of forms (i.e., optical form, radio form, or acoustic form, etc.), and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Bowers et al/Schleipen, well within ordinary skill in the art, and therefore an obvious expedient.

Response to Arguments

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., neither the articles nor the base station need be moved, nor do the articles and the base station need to be in proximity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually (page 6) where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Konishi et al (JP 2000/352,297 A); Gelbart (GB 2,285,550 A); Guthrie (US 5,565,858); Gassmann (US 4,638,171); Theimer et al (US 5,793,630); Hareyama et al (US 5,780,826); Murakami et al (US 6,362,468) are cited as of interest and illustrate a similar structure to a laser locating and tracking system for externally activated tags.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Uyen -Chau Ngo Le

May 4, 2003

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800